

Val Fikovsky

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RESUME OF CREDENTIALS, QUALIFICATIONS AND PROFESSIONAL ACCOMPLISHMENTS

More than thirty years in public research commercialization and business development via patents, licensing, patent infringement dispute resolution, mergers and acquisitions, including:

- Mining of research/identification and evaluation of inventions made at the ten universities and three high physics federal laboratories comprising the UC System; and the Nevada System of Higher Education
- Patent drafting and patent prosecution
- Licensing and technology management
- Oversight of patent firms/patent attorneys in all fields of patent prosecution and patent/licensing enforcement
- Dispute resolution in all forms: litigation, arbitration, mediation, negotiation, inventorship disputes et al.
- Business development, incl. mergers and acquisitions
- Patent legislation & policy development
- Industrial Research/Intellectual Property Management
- International Research & Technology Cooperation
- Research

POSITIONS:

2004-2008 Desert Research Institute/University of Nevada
Joint Technology Transfer Office

- *Director, Special IP Projects*

Duties/Areas:

- Valuation and triage of the DRI/UNR patent portfolio

1981-2004 University of California, Office of the President - Office of Research Administration and Technology Transfer,

- *Director, Physical and Biomedical Licensing Systemwide (90-04)*
- *Director, Technology Assessment & Patent Prosecution System-wide (83-04)*
- *Patent Advisor System-wide (81-83)*

Duties/Areas:

- Mining of research, invention identification and evaluation, patent prosecution;
- Overseeing the work of outside domestic and foreign patent attorneys;
- Patent licensing
- Business development: start-up companies, incubating from research via IP
- Economic development
- Corporate patent gifts to universities
- Research agreements
- Supervision of licensing associates & patent prosecution staff

Scope:

- Evaluated, prosecuted a few thousand U.S. and foreign patents, with cumulative licensing income to UC of \$1 + billion
- As UC system-wide chief patent prosecution officer oversaw the work of multiple attorneys in more than a dozen domestic and foreign patent law firms; developed the UC patent tracking system (largest academic IP database)
- After getting up to speed the UC biotech/pharma patent portfolio started up the UC Physical/Biomedical Sciences Licensing Program in 1990 (run in conjunction with patent prosecution management);
- Negotiated/executed more than one hundred option and license agreements with industry.
- Brought the new Licensing Program from \$0.2 M income in 1990 to \$22 M (\$20M net) income in 2002, financial performance better than comparable programs at other top universities (Stanford, MIT, Columbia, Harvard; i.e. FY02 department generated net licensing income comparable in size to that of the MIT entire tech transfer program, while having unprecedented - 85% - profitability);
- Same year negotiated license agreement carrying largest license issue fee in public sector licensing, \$11M + 2.1M equity
- Patent dispute resolution. Examples:
 - \$200M UC/Genentech settlement (biotech);
 - \$200M settlement UC/Monstanto (biotech);
 - Aneurysm litigation wins in Düsseldorf, London and Hague courts;
 - Increase of royalty rate several fold via successive litigation/arbitration/mediation steps (biomedical lasers case);
- Negotiated large research contracts. Examples:
 - Biomedical - Toshiba/UCSF Magnetic Resonance Imaging, \$65M
- Provided input on pending IP legislation, state and federal
- Raised, negotiated multimillion patent gifts by major US corporations. Examples:
 - Boeing, \$8M
 - Lucent, \$23M
- Start-ups, spin-offs, mergers & acquisitions: Start-up and spin-off companies acquired by large companies on strength of patent portfolios built personally. Examples:
 - MiniMed/MRG acquired by Medtronic, \$3.8 B (implantable device);
 - Target Therapeutics by Boston Scientific, \$1.1B (catheters);
 - Nitres by Cree, \$250M;
 - UNIAx (founder: Nobel Laureate Heeger) by Dupont, \$75M
 - Terabit by Ciena in 2001, \$20M,
 - SignalCom by Microsoft
 - UCSF MRI spin-off, acquired by Toshiba

1980-1981 United States Department of State

- *Consultant, Technology Transfer*

1979-1980 State Committees for Technology, Sofia, Bulgaria

- *Senior Advisor, Tech Transfer*
- Department drafted national tech transfer policy/legislation for Prime Minister Office/Parliament

1978-1979 ETM Inc, Sofia, Bulgaria

- VP, *New Business Development, Patents and Licensing*
- High-tech start-up company, total 200 researchers & other staff

1975-1978 Technika Inc., Sofia, Bulgaria

- *Patent & Licensing Associate*
- Work for the national tech transfer monopoly – in & out licensing of patents & high-tech technologies

1974-1975 School for Reserve Officers, Bulgaria

- *Lieutenant of the Reserve (Defense, Weapons for Mass Destruction)*

1972-1974 National Academy of Sciences & Institute for Industrial Chemistry, Sofia

- *Graduate Student, then Assistant Research Professor*
- Physical Chemistry, Polymers, incl. lab testing if foreign patents work

EDUCATION:

- LL.M Intellectual Property Law, Golden Gate Law School, San Francisco
- Dipl. Patent Expert, Patent Law, VMM Engineering Institute, Sofia
- Dipl. Eng. Chemical Engineering, Institute of Chemical Technology, Sofia

PUBLICATIONS:

- Physical chemistry (mechanisms in pseudo crystallization of polymer macromolecules)
- Comparative Biotech Patent Law (US/EPC/JP – LL.M Dissertation)

MEMBERSHIP:

- Registered to practice, U.S. Patent and Trademark Office, 1982
- Licensing Executives Society (LES), since 1988
- Association of University Technology Managers (AUTM), since 1985
- AIPLA (passive)

RESEARCH

INTERESTS:

- Comparative study, US/European Innovation Systems

LANGUAGES:

- Russian, Bulgarian – fluent; Slavic Group, i.e. Polish, Serbo-Croatian, Macedonian, Czech – semi-fluent
- French, Italian – read, understand; German – technical read, i.e. patents

CITIZENSHIP, DUAL:

- United States.
- European Union